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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,428	10/28/2003	Guenter Schmidt	34874-360/2003P00634US	4467
64280	7590	12/17/2008	EXAMINER	
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY & POPEO, P.C. ONE FINANCIAL CENTER BOSTON, MA 02111			ARAQUE JR, GERARDO	
		ART UNIT	PAPER NUMBER	
		3689		
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		12/17/2008	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/695,428	SCHMIDT ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Gerardo Araque Jr.	3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 22 September 2008.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,3-11,13-16,18-26 and 28 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,3-11,13-16,18-26 and 28 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. In regards to **claims 1 – 11 and 13**, the applicant discloses a “tangible machine-readable storage medium embodying software modules.” The Examiner asserts that unless the data has been executed by a computer or is executable by a computer the program code is non-functional descriptive data. This language does not define the necessary structural and functional interrelationship between the program and the computer so as to permit the computer program's functionality to be realized.
3. **Claims 1 – 11 and 13** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Computer-readable medium as described in the specification is defined as being communication connection that comprises of a wireless signal and at this time signals are currently considered forms of energy and therefore are non-statutory.

### ***Claim Rejections - 35 USC § 112, first paragraph***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 14 – 28** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant has claimed an automated computing system, but has failed to disclose what the automated computing system is. At best, the Examiner has only found support of an automated contracting system, which the Examiner asserts to not be equivalent. Upon reading the specification the Examiner asserts that the automated contracting system does not need to necessarily be a computer since, as broadly understood, the claimed system can be directed to a process of performing the generation of contracting documents without the use of a computer.

***Claim Rejections - 35 USC § 112, second paragraph***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. **Claims 1 – 28** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. In regards to **claim 1**, that applicant claims an article which comprises a tangible machine-readable storage medium. However, the applicant continues to claim contract storage. Consequently, the Examiner is uncertain whether the applicant is claiming another storage device since it is not certain how the storage medium would contain a separate medium within it. The Examiner asserts that claiming two separate storage devices results in having the no longer directed to just an article (medium), but to a system.

9. In regards to **claim 14**, the Examiner is uncertain as to what an automated computer system is. Specifically, the Examiner is uncertain on the differences of a regular computer system and an automated computer system.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 1 – 28** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Davis et al. (US PGPub 2006/0149653 A1)** in view of **Dan et al. (US PG Pub 2002/0178103 A1)**.

12. In regards to **claims 1 and 14**, **Davis** discloses a computer-implemented method of generating contracting documents, comprising:  
receiving a contract renewal indication (**Page 1 ¶ 13 – 14**);  
generating a bid invitation in response to the renewal indication, the bid invitation including a plurality of offered terms and a plurality of requested terms (**Page 2 ¶ 23**; **Page 3 ¶ 34**) and further including supplemental information, the supplemental information including evaluation rules for scoring each bid (**wherein Davis discloses that a buyer can run a "what if" scenario to analyze proposals by permitting the buyer to change one or more terms of a quote and then based upon the same analytical review, observing how the buyer's results are affected in order to assist the buyer in his or her decision making process on which proposal is a better**

**option for the buyer; in other words, the evaluation rules are parameters provided by the buyer and which are used by the computer in order to carry out the "what if" scenario)**

receiving one or more bid responses (**Page 3 – 4 ¶ 35**); and  
a bid aggregator configured to automatically score the bids according to a predetermined scoring standard based on the evaluation rules and being generated prior to the bid invitation, the predetermined scoring standard assigning a relative importance to a plurality of terms within the bids (**Page 2 ¶ 17; Page 10 ¶ 148 Page 11 ¶ 156; Claim 5; wherein Davis discloses that a buyer can run a "what if" scenario to analyze proposals by permitting the buyer to change one or more terms of a quote and then based upon the same analytical review, observing how the buyer's results are affected in order to assist the buyer in his or her decision making process on which proposal is a better option for the buyer. Davis further discloses that the terms include advertising contribution, shipping terms, payment terms, schedule of delivery, quality, and quantity discount) the bid aggregator normalizing values that are bid for the terms within the bid response (**Page 11 ¶ 161 wherein normalization is used to carryout a comparison**).**

**Davis** discloses that contract terms and conditions are posted in order to allow negotiations to take place between a buyer and a seller. Moreover, the initiating user allows the responding user to open its proposal for changes, and a contract may then be awarded. Further still, **Davis** discloses that purchasing events may be replenishment events. Replenishment events are regularly scheduled events at which

previously approved sellers quote on items designated by the purchaser from a list of regularly purchased items (**see Page 1 ¶ 7, 10; Page 4 ¶ 35**).

However, **Davis** fails to explicitly state:

generating a contract by incorporating information from a previous contract and one of the responsive bids.

**Dan**, however, discloses that it is old and well known for contracts to be formed from information provided by one or more parties in one or more electronic documents prior to the negotiation. Specifically, **Dan** teaches that a starting state of a contract can be formed from a previous contract (**see Page 1 ¶ 8; Page 2 ¶ 10; Claim 8**).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view **Davis**, which teaches the concept of replenishment purchasing events that already contain previously approved seller quotes, in view of **Dan**, which teaches that new contract can be formed based on prior contracts, since both teach the concept of using previously used information (seller information and contract information) to create a new agreement.

Regarding the system components to carry out the method steps, **Davis** discloses a method of computer assisted procurement of products to be purchased over an Internet website (**see claim 31, for example**). Although, **Davis** fails to explicitly disclose a storage device, an interface, invitation generator, and contract generator the Examiner asserts that all the components are obviously included. As discussed above, the combination of **Davis** and **Dan** discloses using previously used information to create a new agreement wherein it would have been obvious to one of ordinary skill in

the art that the previously used information must be stored on the computer system, such as in the form of cookies. Further still, **Davis** discloses e-mailing buyer invitations to sellers identified by the buyers, wherein it would have been obvious to one of ordinary skill in the art that the invitations are in electronic form and, thus, would have to have been generated electronically, which also holds true for the contract generator as well. Lastly, all of the above-mentioned steps can only have been accomplished because an interface had to obviously been included, such as an input device like a mouse and keyboard and a monitor so that the website, bids, and other information can be viewed.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention that **the combination of Davis and Dan** obviously included a storage device, interface, and bid invitation generator and contract generator in order to properly carry out the above-mentioned steps.

13. In regards to **claims 3 and 18**, **Davis** discloses further comprising selecting the one of the responsive bids from which the new contract is formed (**obviously included; see also Page 1 ¶ 7, 10; Page 4 ¶ 35**).

14. In regards to **claims 4 and 19**, **Davis** discloses further comprising selecting the highest scoring bidder according to the predetermined scoring standard for the new contract (**Page 1 ¶ 14; Page 4 ¶ 35; Claim 7(ii)**).

15. In regards to **claims 5 and 20**, **Davis** discloses further comprising triggering the generation of a bid invitation upon the occurrence of the pending expiration of a prior contract (**Page 2 ¶ 15, 22**).

16. In regards to **claims 6 and 21**, **Davis** discloses further comprising triggering the generation of a bid invitation upon the meeting of a target quantity on a prior contract (Page 1 ¶ 13, 14).

17. In regards to **claims 7 and 22**, **Davis** discloses wherein a portion of the new contract is formed based on previously agreed upon terms between the buyer and a selected bidder (Page 1 ¶ 7, 13, 14; Page 5 ¶ 96; Page 3 – 4 ¶ 33 – 35; wherein in a replenishment purchasing event sellers have already been pre-approved).

18. In regards to **claims 8 and 23**, **Davis** discloses wherein a portion of the new contract is formed based on provisions selected by the buyer during performance of a prior contract (Page 1 ¶ 7, 13, 14; Page 5 ¶ 96; Page 3 – 4 ¶ 33 – 35; wherein in a replenishment purchasing event sellers have already been pre-approved).

19. In regards to **claims 9 and 24**, **Davis** discloses wherein the bid invitation offers a plurality of selectable provisions associated with a contract clause (Page 2 ¶ 23; Page 3 ¶ 34; Page 1 ¶ 7, 10; Page 4 ¶ 35).

20. In regards to **claims 10 and 25**, **Davis** discloses further comprising generating a summary of terms from two or more of the responsive bids (Page 2 ¶ 17; 4 – 5 ¶ 35).

21. In regards to **claims 11 and 26**, **Davis** discloses further comprising supervising contracting workflow to allow for approval of the new contract (Page 10 ¶ 146; Page 14 ¶ 254).

22. In regards to **claim 13**, **Davis** discloses wherein the bid invitation is provided in the form of a term sheet (Page 2 ¶ 23; Page 3 ¶ 34).

23. In regards to **claim 15, Davis** discloses wherein the contract renewal indication is associated with the expiration of a prior contract (**Page 2 ¶ 15; Page 12 ¶ 205**).

24. In regards to **claim 16, Davis** discloses wherein the contract renewal indication comprises instructions from a user to initiate a new contract (**Page 3 ¶ 33; Page 3 – 4 ¶ 35; Page 10 ¶ 147**).

25. In regards to **claim 28, Davis** discloses wherein the bid invitation is provided in the form of a term sheet, the term sheet comprising an abbreviated form of terms in the contract (**Page 2 ¶ 23; Page 3 ¶ 34; wherein the recipient must click the link to see the full details of the terms**).

#### *Response to Arguments*

26. Applicant's arguments with respect to **claims 1 – 28** have been considered but are moot in view of the new ground(s) of rejection.

#### Rejection under 35 USC 101

27. Rejection under 35 USC 101 toward **claims 1 – 28** have been withdrawn due to amendments.

#### Pertinent Arguments

28. Applicant argues that the **combination of Dan and Davis** fails to disclose or suggest automatically scoring bids based on a predetermined scoring standard.

However, as discussed above, **the combination** provides the user to run a “what if” scenario, which one of ordinary skill in the art would have found it obvious that in order to run the scenario the rules/data required to run the scenario are already stored

within the system in order to allow the buyer run the scenario without requiring an extensive knowledge in programming.

As a result, the Examiner asserts that the **combination of Dan and Davis** does, indeed, disclose or suggest automatically scoring bids based on a predetermined scoring standard.

***Conclusion***

29. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. A./  
Examiner, Art Unit 3689  
12/15/08

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